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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,149	01/05/2001	Miwako Doi	05225.0193	3467

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EXAMINER

TIV, BACKHEAN

ART UNIT PAPER NUMBER

2151

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/754,149	DOI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Backhean Tiv	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 5 and 7-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 6 and 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5, 7-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Detailed Action***

Claims 5,7-16 are pending in this application. Claim 6 has been cancelled.

Claims 1-4,17-24 are withdrawn from consideration. This is a response to the RCE filed on 12/29/05.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5, 7-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 5, 7-16, it is unclear whether the communication control unit or the user identification service provider, or the user non-identification service provider is converting a user identifier of the mobile terminal.

As per claims 5, 7-16, it is unclear who is sending a service request to the non-identification service provider. One can interpret the claim as the user of the mobile terminal is directly sending the request or the user of the mobile terminal is sending the request through the communication control unit to the non-identification service provider or the communication control unit is sending a service request to the non-identification service provider.

Claims 9-11 recites the limitation "the location information", "the parameter", "the service request information". There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the service request identifier", "the service provider name", "the parameter". There is insufficient antecedent basis for this limitation in the claim.

Claims 15-16 recites the limitation "the communication control information", "they type of service". There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 9-11, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,677,894 issued to Sheynblat et al.(Sheynblat) in view of US Patent 6,058,311 issued to Tsukagoshi.

As per claim 5, 14, Sheynblat teaches a service providing system, comprising:  
a location information provider configured to provide a location information of mobile terminal(Fig.1-12, col.1, lines 53-65);

a user identification service provider configured to provide a service requiring a user identification to the mobile terminal of the user(Figs.1-12, col.10, lines 13-44);

a user non-identification service provider configured to provide a service not requiring a user identification to the mobile terminal(col.17, lines 48-58);

a communication control unit configured to control communication among the mobile terminal, the location information provider, the user identification service provider, and the user non-identification service provider(Figs.1-12, col.10, lines 13-44, col.17, lines 48-58)

wherein said communication control unit sends a location information request including a user identifier sent by the mobile terminal to the location information provider(Figs.1-12, col.10, lines 13-44, col.16, lines 25-32), and sends a service request without the temporary identifier to the user non-identification service provider(col.17, lines 48-col.18, line 8).

Sheynblat however does not explicitly teach converts a user identifier of the mobile terminal to a temporary identifier.

Tsukagoshi explicitly teaches converts a user identifier of the mobile terminal to a temporary identifier(col.1, line 67-col.2, line3).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Sheynblat converts a user identifier of the mobile terminal in a service request information sent by the mobile terminal to a temporary identifier as taught by Tsukagoshi in order to obtain service outside of a mobile terminals home area(Tsukagoshi, col.1, lines 1-30).

One of ordinary skilled in the art at the time of the invention would have been motivated to combine Sheynblat, and Tsukagoshi to provide a system in which a user with a mobile device can obtain service outside it's home network area.

As per claim 9, the service providing system according to claim 5,

wherein said service provider stores service request information including the service request identifier(Sheyblat, Figs.1-12, col.10, lines 13-44, col.17, lines 48-58 ), a wireless gateway identifier of said communication control unit(Tsukagoshi, Fig.2-4), the location information and the parameter in response to the service request information sent by said communication control unit(Sheyblat, Figs.1-12, col.10, lines 13-44, col.17, lines 48-58). One ordinary skilled in the art at the time of the invention would have been motivated to combine Sheyblat, and Tsukagoshi, in order to store information of the requested information.

As per claim 10, the service providing system according to claim 9, wherein said service provider creates service information by referring to the parameter, and sends service response information including the service request identifier, the location information and the service information to said communication control unit(Sheyblat, Figs.1-12, col.10, lines 13-44, col.17, lines 48-58).

As per claim 11, the service providing system according to claim 10, wherein said communication control unit reconverts the temporary identifier corresponding to the service request identifier in the service response information to the user identifier in response to the service response information sent by said service provider, and sends the service information to the mobile terminal of the user identifier(Tsukagoshi, Fig.8c).One ordinary skilled in the art at the time of the invention would have been motivated to combine the teachings of Sheyblat, and Tsukagoshi, in order to send information between the communication device and the service provider.

As per claim 15, the service providing system according to claim 14,

wherein said communication control unit sends a user identification service request which is the same as the communication control information to said user identification service provider if the type of the service request is in a user identification service request(Tsukagoshi, col.1, lines 52-5). Motivation to combine set forth in claim 14.

As per claim 16, the service providing system according to claim 15, wherein said communication control unit sends a user non-identification service request which is the communication control information without the temporary identifier to said user non-identification service provider if the type of the service request is a user non-identification service request(Sheyblat, Figs.1-12, col.10, lines 13-44, col.17, lines 48-58).

Claims 7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,677,894 issued to Sheynblat et al.(Sheynblat) in view of US Patent 6,058,311 issued to Tsukagoshi in further view of US Patent 6,072,875 issued to Tsudik.

Sheynblat in view of Tsukagoshi teaches all the limitations of claim 5, however does not explicitly teach as per claim 7, the service providing system according to claim 5, wherein said communication control unit stores a correspondence table between the user identifier and the temporary identifier.

Tsudik teaches two different identifier being corresponded to each other(Abstract).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the teachings of Sheynblat in view of Tsukagoshi to correspond two different identifiers to each other as taught by Tsudik in order to provide a secure identification of a mobile user(Tsudik, col.1, lines 15-20).

One ordinary skilled in the art at the time of the invention would have been motivated to combine the teachings of Sheynblat, Tsukagoshi, and Tsudik in order to provide a system where there is secure identification for a mobile user in a communication network(Tsudik, col.1, lines 15-20).

As per claim 8, the service provided system according to claim 7, wherein said communication control unit converts the user identifier to a different temporary identifier in another service request sent by the mobile terminal(Tsudik, Abstract). Motivation to combine set forth in claim 7.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,677,894 issued to Sheynblat et al.(Sheynblat) in view of US Patent 6,058,311 issued to Tsukagoshi in further view of US Patent 6,636,489 issued to Fingerhut.

Sheynblat in view of Tsukagoshi teaches all the limitations of claim 5, however does not teach as per claim 12, the service providing system according to claim 5, further comprising: a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service request information sent by the mobile terminal through said communication control unit.



Fingerhut teaches a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service request information sent by the mobile terminal through said communication control unit(col.1, lines 41-64).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Sheynblat in view of Tsukagoshi to explicitly add a location independent service provider configured to provide a service independent of the location of the mobile terminal to the mobile terminal in response to service request information sent by the mobile terminal through said communication control unit as taught by Fingerhut in order to provide a wireless subscription management system.

One skilled in the art would have been motivated to combine Sheynblat and Tsukagoshi and Fingerhut in order provide a wireless subscription management system(Fingerhut, col.1, lines 39-41).

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,677,894 issued to Sheynblat et al.(Sheynblat) in view of US Patent 6,058,311 issued to Tsukagoshi in further view of US Patent 6,636,489 issued to Fingerhut in further view of US Patent 6,311,185 issued to Markowitz et al.(Markowitz)

As per claim 13, the service providing system according to claim 12, wherein said communication control unit stores communication control information including the service request identifier(Tsukagoshi, col.1, lines 59-67), the temporary

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identifier(Tsukagoshi, col.1, lines 59-67), and the parameter in response to the service request irrelevant of the location sent by the mobile terminal(Sheyndlat, col.16, lines 25-31), and sends the service request information which is the same as the communication control information to said location independent service provider(Fingerhut, col.1, lines 41-52).

Sheyndlat in view of Tsukagoshi in further view of Fingerhut does not explicitly teach the service provider name(Markowitz, col.3, lines50-67),

Markowitz, teach the service provider name(col.3, lines50-67),

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the system of Sheyndlat in view of Tsukagoshi in further view of Fingerhut to explicitly a service provider name as taught by Markowitz in order to provide a wireless subscription management system.

One ordinary skilled in the art at the time of the invention would have been motivated to combine the teachings of Sheyndlat, Tsukagoshi, Markowitz, and Fingerhut in order to manage a subscription package of services.

### ***Response to Arguments***

Applicant's arguments with respect to claims 5, 7-16 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571)272-3941. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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3/6/06



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